

8/12/07
B 7
108. (New) The process of claim 106, comprising alkyl alkoxylated phosphate ester comprising an alkyl group of 10 to 12 carbon atoms and an alkoxy moiety of 5 ethylene oxide units, phenol ethoxylated phosphate ester, didecyl dimethyl ammonium chloride, and water; and further comprising EDTA, alkalating agent, and C₁₂₋₁₅ linear alcohol.

REMARKS

Applicants have received and reviewed a final Office Action dated February 15, 2000 in the parent application. By way of response, Applicants have canceled claims 1-30 without prejudice and present new claims 31-108. No new matter is presented. Applicants submit the newly presented claims are supported by the specification.

For the reasons given below, Applicants submit the newly presented claims are in condition for allowance and notification to that effect is earnestly solicited.

Examiner Interview

Applicants and Applicants' undersigned representative thank the Examiner for courtesies extended during the personal interview of August 10, 2000.

During the interview, the Examiner and Applicants' undersigned representative discussed a claim proposal including claims reciting a lubricant that is free of fatty acid, and that the cited prior art references disclose only lubricants containing fatty acids. The recitation of a lubricant that is free of fatty acid is supported by Examples in the present application. As the Examiner requested, Applicants provide below authorities indicating that support in the examples is good support for claims.

During the interview, the Examiner questioned whether the application supported independent claims to lubricant that do not recite aryl alkoxy phosphate ester. Again, support for such compositions can be found in the Examples.

Finally, during the interview, the Examiner suggested that recitation of certain ratios for phosphate ester and quaternary ammonium antimicrobial agent might not be sufficient to overcome the prior art rejection over the combination of Despo and Liu references. Applicants respectfully point out below that the Liu reference actually teaches away from the ratios recited in the claims.

Again, Applicants and Applicants' undersigned representative appreciate the Examiner's effort in discussing strategies to yield allowable subject matter in the present application during the personal interview of August 10, 2000.

Guide to the Newly Presented Claims

Newly presented claims 31-44 relate to an antimicrobial phosphate ester conveyor lubricant including phosphate ester and quaternary ammonium antimicrobial agent, but being substantially free of fatty acid. The Examiner has previously objected to terminology employed to describe the present lubricant composition as free of a fatty acid, asserting that the application as filed does not support such a composition. In fact, in the present examples disclose only compositions that are fatty acid free. The sum of the weight percentages of the ingredients in the exemplified compositions totals 100.

Newly presented claims 31-44 do not recite the aryl alkoxylated phosphate ester included in the original claims. Support for compositions lacking an aryl alkoxylated phosphate ester can also be found in the examples of the present application. Examples 3 and 4, at pages 13-17, each include disclosure of formulas and experimental results for lubricants lacking aryl alkoxylated phosphate ester. Examples 3 and 4 provide at least 6 formulas for lubricants lacking aryl alkoxylated phosphate. Figure 3 shows that added alkyl phosphate ester provides lubricity similar to that of added aryl alkoxylated phosphate ester. That is, lubricants can lack aryl alkoxylated phosphate ester. Thus, the present examples provide support for claims that do not recite aryl alkoxylated phosphate ester.

During the recent Examiner interview, the Examiner expressed uncertainty whether examples could properly provide support for a claim limitation, and requested that Applicants' undersigned representative provide authority for such support. Although Applicants representative believes that it is well established that examples can provide support for a claim limitation, the Examiner can review the following authorities.

First, the MPEP at 2163.02 states the well known standard for evaluating amended claims for sufficient written description as "whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter'" (citations omitted). Certainly, having exemplified, in the application as

filed, fatty acid free compositions and compositions lacking an aryl alkyl phosphate ester, Applicant was in possession of such compositions at the time the application was filed.

Further, the MPEP at 2163.02 continues explaining that the "subject matter of the claim need not be described literally (i.e. using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." Thus, this section of the MPEP indicates that the examples included in a patent application as filed can provide support for amended claims without including the words employed in the claim. Hence, by the standards stated in the MPEP, the present specification supports claims to fatty acid free compositions and compositions lacking an aryl alkyl phosphate ester.

The Board of Patent Appeals and Interferences found that a working example of a process that worked without a catalyst was sufficient support for a claim reciting "in the absence of a catalyst". Ex parte Parks 30 USPQ2d 1234 (BPAI 1994) at 1236-1237 (copy enclosed as Exhibit A). The Board found persuasive a declaration stating that "one having ordinary skill in the art would have recognized that the reaction ... is conducted without a catalyst." In the present application, one of ordinary skill can certainly read the examples to see that they describe conveyor lubricants that are fatty acid free or that lack an aryl alkyl phosphate ester. Hence, by standards stated by the Board of Patent Appeals and Interferences, the present specification supports claims to fatty acid free compositions and compositions lacking an aryl alkyl phosphate ester.

The Court of Appeals for the Federal Circuit indicated that words and drawings that convey a concept can provide support for claims using words describing that concept. In re Wright 866 F2d 422 (Fed. Cir. 1989) (copy enclosed as Exhibit B). In the Wright case, the claim was amended to recite particles that are "not permanently fixed" to a support. Although the specification did not literally describe the particles as "not permanently fixed", it did include a description in both words and drawings of a process in which the particles were removed from the support. *Id.* at 423-425. This was held to be sufficient support for the words in the claim. The Court also noted that the written description is decided on the basis of the "specification as a whole". *Id.* at 425. The specification as a whole includes examples. Hence, by standards stated by the Court of Appeals for the Federal Circuit, the present specification supports claims to fatty acid free compositions and compositions lacking an aryl alkyl phosphate ester.

Newly presented claims 45-49 relate to an antimicrobial phosphate ester conveyor lubricant that includes aryl alkoxylated phosphate ester and is free of fatty acid.

Newly presented claims 50-69 relate to an antimicrobial phosphate ester conveyor lubricant including phosphate ester and quaternary ammonium antimicrobial agent in a ratio of 1.5:1 to about 30:1 and lacking aryl alkoxylated phosphate ester. Support for this ratio can be found throughout the specification as filed including at least at page 9, lines 3-13, the Examples, and original claims 2, 3, 12, and 13.

Newly presented claims 67-69 relate to an antimicrobial phosphate ester conveyor lubricant that includes aryl alkoxylated phosphate ester and has a ratio of phosphate ester to quaternary ammonium antimicrobial agent of 1.5:1 to about 30:1.

Newly presented claims 70-83 relate to a process employing an antimicrobial phosphate ester conveyor lubricant including phosphate ester and quaternary ammonium antimicrobial agent, but being substantially free of fatty acid.

Newly presented claims 84-88 relate to a process employing an antimicrobial phosphate ester conveyor lubricant that includes aryl alkoxylated phosphate ester and is free of fatty acid.

Newly presented claims 89-108 relate to a process employing an antimicrobial phosphate ester conveyor lubricant including phosphate ester and quaternary ammonium antimicrobial agent in a ratio of 1.5:1 to about 30:1 and lacking aryl alkoxylated phosphate ester. Support for this ratio can be found throughout the specification as filed including at least at page 9, lines 3-13, the Examples, and original claims 2, 3, 12, and 13.

Newly presented claims 106-108 relate to a process employing an antimicrobial phosphate ester conveyor lubricant that includes aryl alkoxylated phosphate ester and has a ratio of phosphate ester to quaternary ammonium antimicrobial agent of 1.5:1 to about 30:1.

Objection to the Specification

The Examiner objected to the specification asserting that the limitations of originally filed claims 2, 3, 12, and 13 should be added to the specification. Since the originally filed claims are a portion of the specification, the specification cannot be lacking for failure to find words of the originally filed claims in the detailed description of the invention. Nonetheless, to expedite prosecution of this application without acquiescing to the Examiner's objection or

rejection, Applicants have incorporated the recitation of originally filed claims 2, 3, 12, and 13 into the detailed description of the invention by the amendment above. No new matter is presented by this amendment to the detailed description of the invention, for reasons including that the originally filed claims are part of the specification.

Rejection of Claims Under Section 112 Second Paragraph

The Examiner rejected claims 10 and 20 under 35 U.S.C. § 112 second paragraph. The Examiner objected to certain terms employed in these claims. Although this rejection has not been raised for the newly presented claims, it is discussed insofar as it might apply.

Claims 44, 69, 83 and 108, which generally correspond to claim 10, recite that the alkyl alkoxyated phosphate ester includes an alkyl group of 10 to 12 carbon atoms and an alkoxy moiety of 5 ethylene oxide units. Support for this recitation can be found in the specification at least at page 6, lines 8-27. Applicants believe that this recitation provides the clarification requested by the Examiner.

As suggested by the Examiner, each claim that adds an ingredient to the lubricant recites that the lubricant "further comprises" that ingredient.

Accordingly, Applicants respectfully submit that each of the newly presented claims fully complies with section 112, second paragraph, and withdrawal of this rejection is respectfully requested.

Rejection of Claims Under Section 112 First Paragraph

The Examiner rejected claims 21 and 22 under 35 U.S.C. § 112 first paragraph. The Examiner asserts that the originally filed specification does not support claims excluding fatty acid components. Although this rejection has not been raised for the newly presented claims, it is discussed insofar as it might apply.

Applicants respectfully direct the Examiner's attention to at least pages 11-17, which disclose several formulas for lubricants of the present invention, each of which lacks a fatty acid. Authorities indicating that examples are good support for claims are described herein above. Thus, the specification supports claims reciting lubricants excluding fatty acid components.

Accordingly, Applicants respectfully submit that each of the newly presented claims fully complies with section 112, first paragraph, and withdrawal of this rejection is respectfully requested.

Rejection of Claims Under Section 103(a)

The Examiner rejected claims 1-6, 8-9, 11-16, 18-19, and 21-30 under 35 USC section 103(a) as obvious over Despo in view of Liu. Although this rejection has not been raised for the newly presented claims, it is discussed insofar as it might apply. Applicants respectfully traverse this rejection.

Newly presented independent claims 31, 45, 70, and 84 recite that the lubricant is substantially free of fatty acid. The lubricants disclosed in both the Despo and Liu references include fatty acid. Therefore, the Despo and Liu references, either alone or in combination, do not teach or suggest the presently claimed invention.

Newly presented independent claims 50 and 89 recite that phosphate ester and quaternary ammonium antimicrobial agent are present in a particular ratio. The Despo reference does not even mention an antimicrobial agent, and hence cannot disclose a ratio at which it might be present. The Liu reference does not disclose a lubricant containing phosphate ester with an antimicrobial agent, and hence cannot disclose a ratio at which they might be present.

Further, the Liu reference teaches against employing an anionic lubricant in excess of cationic antimicrobial agent. Specifically, at column 11, line 54, through column 12, line 15, the Liu reference teaches that including anionic materials in a lubricant composition "reduces antimicrobial activity in proportion to the amount" of the anionic material employed. The data tables in this passage indicate that quaternary ammonium antimicrobial agent must be present in excess over anionic components of the lubricant for effective antimicrobial activity. In the present claims reciting ratios of anionic lubricant to cationic antimicrobial agent, the anionic material is in excess over the cationic antimicrobial agent. The claimed situation is exactly opposite of that taught by the Liu reference. The Liu reference teaches away from the present independent claims reciting ratios.

Therefore, the Despo and Liu references, either alone or in combination, do not teach or suggest the presently claimed invention.

Accordingly, based on the foregoing differences, is respectfully submitted that the Despo and Liu references cited by the Examiner neither teach nor suggest the presently claimed lubricants and processes, and withdrawal of this rejection is respectfully requested.

Summary

In summary, each of claims 31-108 are in condition for allowance, and notification to that effect is earnestly solicited. The Examiner is invited to contact Applicants undersigned representative if the Examiner believes that doing so will advance prosecution of this application.

Respectfully submitted,

Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
612.332.5300

Date: _____

Sept 15, 2000

Mark T. Skoog
Mark T. Skoog
Reg. No. 40,178

1234

Ex parte Parks

30 USPQ2d

years' worth of license fees, or \$1,260, since the date of its first letter to defendants on September 23, 1933 informing them that they were required to sign a license agreement. By imposing the statutory minimum of \$500 per number of works infringed,³ defendants will be required to pay \$11,500, approximately nine times the amount defendants would have paid in licensing fees. This Court finds that to be an appropriate penalty for the defendants' infringements.

Finally, the Copyright Act provides that the court "in its discretion may allow the recovery of full costs [and] may also award a reasonable attorney's fee to the prevailing party as part of the costs." 17 U.S.C. § 505. In order to encourage suits to redress copyright infringement, attorney fees are awarded to a prevailing plaintiff as a matter of course. *Frost Belt Int'l Recording Enterprises, Inc. v. Cold Chillin' Records*, 758 F.Supp. 131, 140 (S.D.N.Y. 1990). The award of attorney's fees is the rule rather than the exception. *Micromanipulator Co. v. Bough*, 779 F.2d 255, 259 [228 USPQ 443] (5th Cir. 1985). Consequently, this Court finds plaintiffs entitled to reasonable attorney's fees for the prosecution of this action.

The declaration of Marjorie R. Esman submitted by plaintiffs states that plaintiffs incurred \$1,747.00 in attorney's fees for services, including: preparation and service of discovery materials, participation in a scheduling conference; preparation of and filing of a witness and exhibit list; preparation and filing of the motion for summary judgment. The declaration states that plaintiffs incurred costs and expenses in the amount of \$485.37 for filing of the complaint, payments to the process server, reasonable photocopies, and long distance telephone charges. This Court finds these declared attorneys' fees, costs and expenses to be reasonable.

Conclusion

For the reasons set forth above,
IT IS ORDERED that plaintiffs' motion for summary judgment is hereby GRANTED in all respects except plaintiffs' request

³ See *Frank Music Corp. v. Metro-Goldwyn-Mayer Inc.*, (9th Cir.), 886 F.2d 1545 [12 USPQ2d 1412], cert. den'd 110 S.Ct. 1321, 494 U.S. 1017 (1989) which states that the number of works infringed is the appropriate calculation for statutory damages and not the number of infringements. The affidavit of James Hutcherson, investigator for BMI, lists 23 works which were infringed on July 11, 12, 18, and 19, 1992.

for statutory damages in the amount of \$2,500 per claim of infringement. Accordingly, defendants are liable to plaintiffs in the amount of \$11,500 in statutory damages for copyright infringements, \$1,747.00 in attorney's fees, and \$485.37 in costs and expenses. Judgment will be so entered.

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Ex parte Parks

No. 93-2740

Decided September 2, 1993

Released January 4, 1994

PATENTS

1. Practice and procedure in Patent and Trademark Office — Reissue — Broader claims sought (§110.1313)

Patentability/Validity — Specification — Written description (§115.1103)

Claims in reissue application for method of determining nitrogen content of sample were improperly rejected on ground of inadequate descriptive support under 35 USC 112, first paragraph, since originally-filed disclosure need only convey, to one of skill in art, that applicant had possession of concept of what is claimed in order to satisfy description requirement, since lack of literal basis in disclosure for limitation that decomposition step of claims be "conducted in the absence of a catalyst" thus does not establish prima facie case for lack of descriptive support, and since it cannot be held that originally-filed disclosure would not have conveyed concept of effecting decomposition at elevated temperature in absence of catalyst.

2. Practice and procedure in Patent and Trademark Office — Reissue — Broader claims sought (§110.1313)

Claims in reissue application for method of determining nitrogen content of sample are overbroad under 35 USC 251, since application was filed more than two years after grant of original patent, since any claim which does not contain negative limitation expressly excluding presence of catalyst in decomposition step of method is broader than original claims, and since claims in question do not accomplish such exclusion by reciting phrase "consisting essentially of" in characterizing decomposition step.

30 USPQ2d

Particular patents — gen detection

4,018,562, Parks and
luminescent nitrogen (c
and method, claims 81-8
reissue rejected.

Appeal from final re
application for reissue (c
ston, primary examiner)

Application of Robert
ert L. Marietta, serial no
31, 1991, continuation of
filed April 18, 1989 a
reissue of patent no.
April 19, 1977 on ap
625,510, filed Oct.
luminescent nitrogen (c
and method). From fi
claims in application, ap
jection of claims 1-10,
94-106 reversed; reject
affirmed.

Before Calvert, vice ch
and Tarring, examine

Steiner, examiner-in-c

This is an appeal from
of claims 1 through 10, 2
through 106, all the cla
tion for reissue of Patent
'562 patent).

THE INV.

The claimed invention
determining the nitrogen
comprising manipulative
decomposing the sample
gas atmosphere at an e
to obtain nitric oxide an
ated nitric acid to unde
cent reaction with ozone
Claims 1, 81 and 94
read as follows:

1. The method for c
chemically combined
sample comprising th
a. decomposing said
in the presence of a
sphere of oxygen and
temperature sufficien
that substantially all
bound nitrogen is reco
(NO), such decompo
ed in the absence of a

dry damages in the amount of claim of infringement. Accord-
 -dants are liable to plaintiffs in
 t of \$11,500 in statutory damages
 ght infringements, \$1,747.00 in
 fees, and \$485.37 in costs and
 judgment will be so entered.

**Patent and Trademark Office
 Patent Appeals and Interferences**

Ex parte Parks

No. 93-2740

Decided September 2, 1993
 Released January 4, 1994

**and procedure in Patent and
 mark Office — Reissue —
 or claims sought (§110.1313)**

**ility/Validity — Specification —
 n description (§115.1103)**

1 reissue application for method
 ing nitrogen content of sample
 properly rejected on ground of inad-
 -riptive support under 35 USC
 aragraph, since originally-filed
 eed only convey, to one of skill in
 allicant had possession of concept
 aimed in order to satisfy descrip-
 -ment, since lack of literal basis in
 or limitation that decomposition
 ns be "conducted in the absence
 t" thus does not establish prima
 r lack of descriptive support, and
 not be held that originally-filed
 ould not have conveyed concept
 decomposition at elevated tem-
 -absence of catalyst.

**and procedure in Patent and
 ark Office — Reissue —
 r claims sought (§110.1313)**

reissue application for method
 ing nitrogen content of sample
 ad under 35 USC 251, since
 was filed more than two years
 of original patent, since any
 does not contain negative limita-
 -y excluding presence of catalyst
 ition step of method is broader
 l claims, and since claims in
 ot accomplish such exclusion by
 se "consisting essentially of" in
 ig decomposition step.

**Particular patents — Chemical — Nitro-
 gen detection**

4,018,562, Parks and Marietta, chemi-
 luminescent nitrogen detection apparatus
 and method, claims 81-93 in application for
 reissue rejected.

Appeal from final rejection of claims in
 application for reissue of patent (Jill John-
 ston, primary examiner).

Application of Robert E. Parks and Rob-
 ert L. Marietta, serial no. 708,810, filed May
 31, 1991, continuation of serial no. 340,540,
 filed April 18, 1989 and abandoned, for
 reissue of patent no. 4,018,562, granted
 April 19, 1977 on application serial no.
 625,510, filed Oct. 24, 1975 (chemi-
 luminescent nitrogen detection apparatus
 and method). From final rejection of all
 claims in application, applicants appeal. Re-
 jection of claims 1-10, 20-22, 55-80, and
 94-106 reversed; rejection of claims 81-93
 affirmed.

Before Calvert, vice chairman, and Steiner
 and Tarring, examiners-in-chief.

Steiner, examiner-in-chief.

This is an appeal from the final rejection
 of claims 1 through 10, 20 through 22 and 55
 through 106, all the claims in this applica-
 tion for reissue of Patent No. 4,018,562 (the
 '562 patent).

THE INVENTION

The claimed invention is a method for
 determining the nitrogen content of a sample
 comprising manipulative steps which include
 decomposing the sample in an oxygen/inert
 gas atmosphere at an elevated temperature
 to obtain nitric oxide and causing the gener-
 ated nitric acid to undergo a chemilumines-
 cent reaction with ozone.

Claims 1, 81 and 94 are illustrative and
 read as follows:

1. The method for determining the total
 chemically combined nitrogen content of a
 sample comprising the steps:

a. decomposing said sample in one step
 in the presence of an oxygen-rich atmo-
 sphere of oxygen and an inert gas and at a
 temperature sufficiently above 700°C.
 that substantially all of the chemically
 bound nitrogen is recovered as nitric oxide
 (NO), such decomposition being conduct-
 ed in the absence of a catalyst,

b. causing the nitric oxide produced by
 such decomposition to undergo a chemilu-
 minescent reaction with ozone, and

c. determining the magnitude of the
 chemiluminescent reaction to indicate the
 quantity of chemically combined nitrogen
 in said sample.

81. A method for determining the total
 chemically combined nitrogen content of
 a sample, said method comprising the
 steps of:

(a) decomposing said sample in one
 step, said decomposing step consisting es-
 sentially of decomposing said sample in
 the presence of an oxygen-rich atmo-
 sphere of oxygen and an inert gas and at a
 temperature sufficiently above 700°C
 that substantially all of the chemically
 bound nitrogen is recovered as nitric acid
 (NO);

(b) causing the nitric oxide produced by
 such decomposition to undergo a chemi-
 luminescent reaction with ozone; and

(c) determining the magnitude of the
 chemiluminescent reaction to indicate the
 quantity of chemically combined nitrogen
 in said sample.

94. A method for determining the total
 chemically combined nitrogen content of
 a sample, said method comprising the
 steps of:

(a) decomposing said sample in one
 step in the presence of an oxygen-rich
 atmosphere of oxygen and an inert gas
 and at a temperature sufficiently above
 700°C that substantially all of the chemi-
 cally bound nitrogen is recovered as nitric
 oxide (NO) according to the formula:



(b) causing the nitric oxide produced by
 such decomposition to undergo a chemi-
 luminescent reaction with ozone; and

(c) determining the magnitude of the
 chemiluminescent reaction to indicate the
 quantity of chemically combined nitrogen
 in said sample.

THE REJECTIONS

Claims 1 through 10, 20 through 22 and
 55 through 80 stand rejected under the first
 paragraph of 35 U.S.C. 112 for lack of
 adequate descriptive support. Claims 81
 through 106 stand rejected under 35 U.S.C.
 251 in that they are broader than the origi-
 nally patented claims.¹ In addition, all the

¹ The ultimate paragraph of 35 U.S.C. 251
 reads as follows:

No reissued patent shall be granted enlarging
 the scope of the claims of the original patent
 unless applied for within two years from the
 grant of the original patent.

appealed claims stand rejected under 35 U.S.C. 251 for lack of the requisite "error."

The rejection under the first paragraph of 35 U.S.C. 112, the rejection of claims 94 through 106 under 35 U.S.C. 251 as broader than the original claims, and the rejection of all the appealed claims under 35 U.S.C. 251 for lack of the requisite "error" are reversed; the rejection of claims 81 through 93 under 35 U.S.C. 251 as broader than the original claims is affirmed.

OPINION

The Rejection of Claims 1 through 10, 20 through 22 and 55 through 80 under the first paragraph of 35 U.S.C. 112.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention on any ground is always upon the examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support, it is incumbent upon the examiner to establish that the originally-filed disclosure would not have reasonably conveyed to one having ordinary skill in the art that an appellant had possession of the now claimed subject matter. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). Adequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention. *In re Herschler*, 591 F.2d 693, 200 USPQ 711 (CCPA 1979); *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

[1] The examiner contends that the rejected claims lack adequate descriptive support because there is "no literal basis for the" claim limitation "in the absence of a catalyst." Clearly, the observation of a lack of literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112. *In re Herschler*, *supra*; *In re Edwards*, *supra*; *In re Wertheim*, *supra*.

² See page 4 of the Answer, second full paragraph, line 4, and page 7 thereof, last two lines.

The examiner notes that in *Parks v. Fine*, 773 F.2d 1577, 227 USPQ 432 (Fed. Cir. 1985), involving the claimed subject matter, the limitation "in the absence of a catalyst" was considered material. Suffice it to say, no issue under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support for the limitation "in the absence of a catalyst" was before the court.

We are not unmindful of the decision in *Ex parte Grasselli*, 231 USPQ 393 (Bd.App. 1983) *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984), which involved claims to a process for the ammoxidation of propane or isobutane employing a catalyst "free of uranium and the combination of vanadium and phosphorus." Under the particular facts in that case, it was held that the negative limitation introduced new concepts in violation of the description requirement of the first paragraph of 35 U.S.C. 112, citing *In re Anderson*, *supra*. In the situation before us,³ it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art that appellants had possession of the concept of conducting the decomposition step generating nitric acid in the absence of a catalyst. See, for example, column 5 of the '562 patent, first paragraph, wherein FIG. 4 is discussed. Pyrolysis temperatures of between 600°C and 700°C, and above 700°C were employed to achieve conversion of chemically bound nitrogen to nitric oxide. Smooth conversion was obtained above 700°C, while the optimum conversion was found to occur above 900°C. Throughout the discussion which would seem to cry out for a catalyst if one were used, no mention is made of a catalyst.⁴

Moreover, according to two declarations by Wentworth, a professor of chemistry at the University of Houston, whose expertise in this particular art has not been challenged, one having ordinary skill in the art would have recognized that the reaction generating nitric oxide, according to the equation disclosed in the '562 patent, is conducted without a catalyst. See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d

³ Whether the requirement for an adequate written description has been met is a question of fact and, hence, driven by the exigencies of each case. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

⁴ A "catalyst" normally functions to accelerate a particular reaction. See for example, Hawley, *Condensed Chemical Dictionary*, Tenth Edition, 1981, pp. 205 and 206, copies of which are enclosed for appellants' convenience and made of record.

1111 (Fed. Cir. 1991); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). 864, 150 USPQ 546 (CC cannot be said that the original disclosure would not have conveyed ordinary skill in the art that an appellant had possession of the concept of what is claimed in the absence of a catalyst, *supra*.

Accordingly, the examination of claims 1 through 10, 20 through 80 under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support is reversed.

The Rejection of Claims 81 through 93 under 35 U.S.C. 251 as Original Claims.

We initially observe that the Brief,

appellants agree that the reissue application that limitation that means "catalyst" is broader than the limitation in 35 U.S.C. 251 (appellants' Brief).

Claims 81 through 10 negative limitation which excludes the presence of a catalyst. Appellants contend that the limitation excludes the presence of a catalyst. The phrase "consisting essentially of" characterizing the decomposition reaction that claims 94 through 106 excludes the presence of a catalyst by virtue of the equation for the decomposition reaction which equation does not include a catalyst.

[2] In our opinion, the limitation "consisting essentially of," as employed in claims 81 through 93, limits decomposition step and, in that sense, decomposition is performed. However, it is not apparent why appellants have not explained why the limitation "consisting essentially of" excludes a catalyst during the decomposition step. It would, the claims 81 through 93 are properly rejected by the U.S.C. 251. Accordingly, the rejection of claims 81 through 93 under 35 U.S.C. 251 is affirmed.

Claims 94 through 106 position reaction in a manner that to the Wentworth that no catalyst was employed.

⁵ Compare *Moleculon CBS, Inc.*, 793 F.2d 1261, note 6 (Fed. Cir. 1986).

hat in *Parks v. Fine*, SPQ 432 (Fed. Cir. imed subject matter, bsence of a catalyst" l. Suffice it to say, no agraph of 35 U.S.C. e descriptive support e absence of a cata- irt.

ul of the decision in USPQ 393 (Bd.App. F.2d 453 (Fed. Cir. aims to a process for ropane or isobutane ree of uranium and adium and phospho- ar facts in that case, tive limitation intro- violation of the de- f the first paragraph ng *In re Anderson*, before us,³ it cannot ally-filed disclosure d to one having ordi- hat appellants had t of conducting the rating nitric acid in t. See, for example, ent, first paragraph, ssed. Pyrolysis tem-)°C and 700°C, and oyed to achieve con- ound nitrogen to ni- ersion was obtained optimum conversion e 900°C. Through- i would seem to cry ere used, no men- t.⁴

to two declarations sor of chemistry at on, whose expertise has not been chal- ary skill in the art at the reaction gen- ording to the equa- tent, is conducted *Vas-Cath, Inc. v. 1555*, 19 USPQ2d

ent for an adequate n met is a question of the exigencies of each *nc. v. Toshiba Corp.*, 2d 1767 (Fed. Cir.

functions to acceler- ee for example, *Haw- ictionary*, Tenth Edi- i, copies of which are venience and made of

1111 (Fed. Cir. 1991); *In re Lemin*, 364 F.2d 864, 150 USPQ 546 (CCPA 1966). Thus, it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art the concept of effecting decomposition at an elevated temperature in the absence of a catalyst. *In re Anderson, supra*.

Accordingly, the examiner's rejection of claims 1 through 10, 20 through 22 and 55 through 80 under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support is reversed.

The Rejection of Claims 81 through 106 under 35 U.S.C. 251 as Broader than the Original Claims.

We initially observe that on page 6 of the Brief,

appellants agree that any claim in the reissue application that does not contain a limitation that means "in the absence of a catalyst" is broader than original claims 1-10 and hence unpatentable under 35 USC 251 (appellants' emphasis).

Claims 81 through 106 do not contain a negative limitation which expressly precludes the presence of a catalyst. However, appellants contend that claims 81 through 93 exclude the presence of a catalyst by virtue of the phrase "consisting essentially of" in characterizing the decomposition step, and that claims 94 through 106 exclude the presence of a catalyst by virtue of the recited equation for the decomposition reaction, which equation does not reflect the presence of a catalyst.

[2] In our opinion, the phrase "consisting essentially of," as employed in claims 81 through 93, limits decomposition to a single step and, in that sense, is redundant since decomposition is performed "in one step." However, it is not apparent and appellants have not explained why the expression "consisting essentially of" excludes the presence of a catalyst during the recited decomposition step.⁵ It would, therefore, appear that claims 81 through 93 are broader than original claims 1 through 10 and, hence, were properly rejected by the examiner under 35 U.S.C. 251. Accordingly, the examiner's rejection of claims 81 through 93 under 35 U.S.C. 251 is affirmed.

Claims 94 through 106 recite the decomposition reaction in a manner which, according to the Wentworth declarations, means that no catalyst was employed. *In re Lemin*,

⁵ Compare *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805, 812, note 6 (Fed. Cir. 1986).

supra. Accordingly, claims 94 through 106 would not appear broader than original claims 1 through 10 and, hence, the examiner's rejection of claims 94 through 106 under 35 U.S.C. 251 is reversed.

The Rejection of the Appealed Claims Under 35 U.S.C. 251 for Lack of the Requisite Error.

This rejection is reversed essentially for the reasons advocated by appellants on appeal. We emphasize that the practice of submitting claims as a hedge against the possible invalidity of original claims has been judicially sanctioned. See, for example, *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556, 11 USPQ2d 1750 (Fed. Cir. 1989); *In re Altenpohl*, 500 F.2d 1151, 183 USPQ 38 (CCPA 1974); *In re Handel*, 312 F.2d 943, 136 USPQ 460 (CCPA 1963).

In summary, the examiner's rejection of claims 81 through 93 is affirmed; the rejection of claims 1 through 10, 20 through 22, 55 through 80 and 94 through 106 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

AFFIRMED-IN-PART.

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Ex parte Heymes

No. 93-1646

Decided November 9, 1993

Released January 4, 1994

PATENTS

1. Patentability/Validity — Obviousness — Relevant prior art — Particular inventions (§115.0903.03)

Patentability/Validity — Obviousness — Secondary considerations generally (§115.0907)

Application claims for chemical compounds were properly rejected as obvious under 35 USC 103, since claims are prima facie obvious in view of cited references, since record does not show that claimed compounds, which are intermediates to patented compounds having antibiotic properties, have no known utility other than as

question of law." *Swift & Co. v. Hocking Valley Ry. Co.*, 243 U.S. 281, 289, 37 S.Ct. 287, 289, 61 L.Ed. 722 (1917). *Accord, Estate of Sanford v. Commissioner*, 308 U.S. 39, 51, 60 S.Ct. 51, 59, 84 L.Ed. 20 (1939) ("We are not bound to accept, as controlling, stipulations as to questions of law.").

CONCLUSION

The judgment of the district court awarding Alpkem \$600,000 on its antitrust counterclaim is vacated, and the case is remanded to the district court for further proceedings consistent with this opinion.

No costs.

VACATED AND REMANDED.

NIES, Circuit Judge, joining with additional comments.

I join the majority's decision to remand rather than dismissing outright. In doing so, however, I have given the parties the benefit of the doubt that they are not attempting improperly to manipulate the court into rendering an opinion on validity even though there appears to be no viable case or controversy which would require us to make the decision. The doubt arises not only because of the contrived nature of the stipulation *sub judice*, but also because, in the earlier appeal, the parties presented this court, just before hearing, with a stipulation of non-infringement and sought a ruling only on validity. When the court pointed out that the appeal would be mooted by the stipulation, the parties jointly withdrew it. Now the parties have stipulated that all elements of the antitrust claim are present except for a judicial determination of enablement or lack thereof. The stipulation would appear to include an admission by Technicon that it brought this suit in bad faith. The particular grounds of bad faith are not specified. At this junction Technicon has failed to show that the enablement issue which they ask us to decide is at all relevant to the antitrust claim. It also appears to be inconsistent with Technicon's position in this appeal. Alternatively, the parties cannot validly stipulate that lack of enablement in itself results in an antitrust violation. Such an

attempt would be invalid because the parties may not stipulate as to the legal effect of the enablement issue. *See Swift & Co. v. Hocking Valley Ry. Co.*, 243 U.S. 281, 289, 37 S.Ct. 287, 289, 61 L.Ed. 722 (1917) (stipulation a nullity whether treated as an agreement to legal effect of admitted facts or as establishing facts contrary to record); *accord Saviano v. Commissioner of Internal Revenue*, 765 F.2d 643, 645 (7th Cir. 1985) (while parties are free to stipulate to factual elements, court is not bound by legal conclusions); *Noel Shows, Inc. v. United States*, 721 F.2d 327, 330 (11th Cir. 1983) (stipulation by parties as to question of law not binding on court); *Marden v. International Ass'n of Machinists & Aerospace Workers*, 576 F.2d 576, 580 (5th Cir. 1978) (court free to disregard stipulation if parties have spoken to legal effect of facts since court cannot be controlled by agreement on subsidiary question of law); *Mead's Bakery, Inc. v. Commissioner of Internal Revenue*, 364 F.2d 101, 106 (5th Cir. 1966) (court not bound by stipulations of law or by stipulations of fact which appear contrary to facts disclosed by the record).



In re Richard F. WRIGHT.

No. 88-1521.

United States Court of Appeals,
Federal Circuit.

Jan. 24, 1989.

Appeal was taken from United States Patent and Trademark Office Board of Patent Appeals and Interferences, affirming examiner's rejection of claims concerning method for forming images using free-flowing photosensitive microcapsules. The Court of Appeals, Rich, Circuit Judge, held that: (1) applicant did not impermissibly

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amend specification in patent application, and (2) application was not invalid for obviousness.

Reversed.

1. Patents \Rightarrow 109

When scope of patent claim has been changed by amendment in such a way as to justify assertion that it is directed to different invention than was original claim, it is proper to inquire whether newly claimed subject matter was described in patent application when filed as invention of applicant. 35 U.S.C.A. § 112.

2. Patents \Rightarrow 109

Applicant for patent for method performing images using photosensitive microcapsules did not impermissibly amend specification in patent application by adding limitation that microcapsules not be "permanently fixed." 35 U.S.C.A. § 112.

3. Patents \Rightarrow 16.15, 16.23

Patent application's claims for method of forming images using free-flowing photosensitive microcapsules were not invalid for obviousness. 35 U.S.C.A. § 103.

Mark P. Levy, Smith & Schmacke, Dayton, Ohio, argued, for appellant. With him on the brief was Richard H. Saylor.

Harris A. Pitlick, Office of the Sol., Arlington, Va., argued, for appellee. With him on the brief were Fred E. McKelvey, Sol. and Charles A. Wendel, Associate Sol.

Before FRIEDMAN and RICH, Circuit Judges, and BENNETT, Senior Circuit Judge.

RICH, Circuit Judge.

This appeal is from the decision of the United States Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences (board) affirming the examiner's rejection of claims 1-20, all the claims of application serial No. 770,538, filed August 28, 1985 for "Method for Forming Images Using Free Flowing Photosensitive Microcapsules." We reverse.

All claims have been treated by both the PTO and appellant Wright as a group and stand rejected on two distinct grounds: (1) obviousness under 35 U.S.C. § 103 in view of the disclosures of U.S. patents to Macaulay, No. 3,016,308, and Sanders, No. 4,440,846, the latter being assigned to the Mead Corporation, Dayton, Ohio, assignee of Wright's application at bar, the real party in interest; and (2) a rejection based on 35 U.S.C. § 112 and predicated on the addition to all three independent claims as originally filed of an identical limitation, in order to distinguish the invention from prior art. The PTO contends the limitation is not supported by the specification. This limitation is shown in italics in illustrative claim 1 reproduced below.

There are three independent claims, 1, 6, and 13, the rest of the 20 claims being variously dependent. The rejections do not necessitate any separate consideration. Claim 1 in its present form reads (emphasis ours):

1. A method for forming images which comprises:

depositing a uniform layer of photosensitive microcapsules on the surface of a support, said microcapsules being in the form of a free-flowing powder *which is distributed upon said support but not permanently fixed thereto, said microcapsules comprising a discrete capsule wall containing a photosensitive composition and said microcapsules having associated therewith an image-forming agent,*
image-wise exposing said layer of photosensitive microcapsules to actinic radiation,

subjecting said layer of microcapsules to a uniform rupturing force such that said microcapsules rupture and image-wise release said internal phase, and

removing microcapsules from said support.

In the application as filed, claim 1 was exactly the same except that the word "and" took the place of the emphasized clause, which was added later. The examiner's § 112 rejection was explained by him in his Answer on appeal to the board as follows:

It is the position of the examiner that new limitation to microcapsule having term "not permanently fixed" is not supported in the disclosure and therefore is a new matter. The words "not permanently fixed" do not appear in the specification as originally filed and it is questionable whether appellant's specification, unequivocally teaches the absence of permanently fixed microcapsules.

This is the rejection under § 112 which the board sustained but in doing so it added its own thinking in a somewhat different vein:

We shall sustain this rejection. We agree with appellant that the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112. [case omitted] Nonetheless, the question remains as to whether the meaning of "not permanently fixed thereto" is sufficiently described in the specification to inform the public what said language is intended to encompass. From our review of the present disclosure, we are convinced that this limitation is subject to different interpretations and the specification is devoid of adequate guidelines to direct the public to the correct meaning. In this connection, it will be noted that the disputed terminology is not limited to a *temporary* positioning of the microcapsules on the support, but would include a relatively protracted, but "not permanent", bonding of the microcapsules to the support.

Despite the self-evident differences between what the examiner said and what the board said, the board did not suggest that it was making a new rejection under 37 CFR 1.196(b).

Although the examiner did not mention "the description requirement of § 112," the board apparently took that to be the true basis of the examiner's rejection, notwithstanding the fact that its own reasoning partakes more of the notion that "not permanently fixed" is either vague and indefinite or of indeterminate breadth. But these were not stated to be grounds of rejection.

The brief for the Solicitor of the PTO, in the three pages devoted to the § 112 rejection, repeats what the board said and attempts to clarify it by saying:

[T]he inquiry is whether [an] artisan is made aware from the description in appellant's specification that he regarded as part of his invention—and so described in the specification—the concept that the microcapsules are "not permanently fixed."

And again:

The present case does not involve a breadth-description matter; the present case involves a definition-description matter, i.e., whether the specification describes the invention in a way to justify the manner in which it is now claimed.

The Section 112 Rejection

[1,2] When the scope of a claim has been changed by amendment in such a way as to justify an assertion that it is directed to a *different invention* than was the original claim, it is proper to inquire whether the newly claimed subject matter was *described* in the patent application when filed as the invention of the applicant. That is the essence of the so-called "description requirement" of § 112, first paragraph, which opens with the words: "The specification shall contain a written description of the invention...." The invention is, necessarily, the subject matter defined in the claim under consideration. The question arises in a variety of situations some of which are catalogued in *In re Smith*, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973). As our predecessor court said in that case:

The specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. *In re Ruschig*, supra, 54 CCPA [1551] at 1559, 379 F.2d [990] at 996, 154 USPQ [118] at 123. When the original specification accomplishes that, regardless of *how* it accomplishes it, the essential goal of the description requirement is realized.

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In deciding the issue, the specification as a whole must be considered.

As also pointed out in *Smith* and as admitted by the board, "the claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement." The fact, therefore, that the exact words here in question, "not permanently fixed", are not in the specification is not important. From the wording of the examiner's rejection it would seem that he did not know that; at least he wanted to be shown an "unequivocal teaching" that the microcapsules are not permanently fixed. The board, on the other hand, launched into a discussion of whether the *meaning* of the words is clear and whether the specification contains "guidelines" as to what they mean. It felt the words were open to "different interpretation", which goes to the *scope* of the phrase rather than support for it. We deem this to be an irrelevant inquiry. These are common, garden variety words known to every English-speaking person. The Associate Solicitor who argued this appeal (who was not the author of the brief) said he had no difficulty understanding their meaning, nor do we.

We have read the specification, in the light of which all that the claims say must be construed, and we have considered it against the background of the prior art partially shown by the references relied on. We are fully convinced that the process of the claims, containing the words "not permanently fixed", is described in the specification.

The method disclosed in both words and drawings comprises four manipulative steps: 1. microcapsules in the form of a free-flowing powder are *deposited* on a support; 2. the layer of powder is *exposed* to actinic radiation; 3. the powder layer is subjected to a *rupturing* force; 4. the capsules are *removed* from the support. When rupturing takes place it is done against a "web" such as a sheet of paper to which the image is transferred and the specification's examples warn that until the image is formed, by the rupture, it is important that the microcapsules not be dis-

turbed so as to change their position, showing that they are not permanently fixed on their support at that time. The 4th or last step in the method is removing the microcapsules from the support on which they were deposited as a free-flowing powder, the removal being by "wiping, brushing, and/or using vacuum means." In one embodiment of the invention, the support is an electrically charged drum such as is used in xerographic office copiers, the powder being "cascade coated" onto the drum. The specification says that in such case the removal step can be accomplished simply by discharging the drum surface. The drawing for that embodiment shows a "cleaner means 40" which removes powder from the drum following the rupturing step, removing both "the ruptured and unruptured microcapsules."

All of this convinces us that it is of the essence of the original disclosure that the microcapsules are "not permanently fixed" to their various supports. The examiner was therefore wrong in his underlying premise that the limitation added to the claim by amendment contained "new matter." The specification does unequivocally teach the absence of permanently fixed microcapsules. The § 112 rejection was clearly erroneous and cannot stand. There is clear compliance with the description requirement.

The § 103 Obviousness Rejection

[3] In rejecting all claims under § 103 on Sanders in view of Macaulay, the examiner said in his Answer, in response to appellant's argument:

The Examiner's conclusion of obviousness is not based on what the individual references themselves suggest, but [on] what logic and scientific reasoning taken with the combination of reference disclosures taken as a whole have suggested to one of ordinary skill in the art.

Whatever that unusual statement, quoted by the board without any suggestion of criticism, may be taken to mean, the board proceeded to make its own interpretations of Sanders and Macaulay. In discussing Sanders, the board begins with the state-

ment, "we appreciate that the patentee [Sanders] does not disclose the use of free-flowing capsule powders to prepare his coating." The board makes no effort to establish obviousness on the basis of Sanders alone and the Solicitor takes the same position, stating in footnote 8 of his brief, "The rejection has always been based upon a combination of Sanders and Macaulay under 35 U.S.C. § 103." The examiner's expressed view of Sanders is stated in his Answer as follows:

The Examiner asserts that ... Sanders et al '846 teach a method for forming images which comprises exposing a layer of Photosensitive microcapsules on the surface of the substrate and that *it differs from the claimed invention in having precoated imaging sheets with microcapsules rather than photosensitive microcapsules coated on a support as a free-flowing powder.* [Emphasis ours.]

Both the examiner and the board having looked to Macaulay's disclosure as suggesting to those skilled in the art the use of the microcapsules in appellant's claimed process in the form of a free-flowing powder upon a support, not permanently attached thereto and finally removed, our principal task is to examine Macaulay, particularly the portions specifically relied on.

Macaulay is a fairly early patent in this relatively recent art. Application was filed in 1957 and the patent issued in 1962. Its title is "Recording Paper Coated with Microscopic Capsules of Coloring Material. Capsules and Method of Making." The recording paper product came to be known as "carbonless paper," referred to in the specification at bar. We judicially notice its widespread current use in manifold business forms in which the colorless coating on the back of a form causes writing to appear on an underlying sheet when the one above it is written on with a pencil or ball-point pen. The coating consists of microcapsules which are ruptured by the writing pressure to release a color-former. That is what Macaulay describes. First he describes how to make microcapsules and then he describes making his "recording paper" by coating paper with the microcapsules with the aid of a variety of binders.

We have carefully read every word of the Macaulay specification, paying particular attention to the passages relied on by the examiner, the board, and the Solicitor. Our conclusion is that nowhere does Macaulay suggest using microcapsules, which necessarily are in the form of a free-flowing dry powder to begin with, except by coating them on a sheet of paper or similar web material with the aid of a binder. We also conclude that the PTO's attempt to show the contrary consists of taking statements wholly out of context and giving them meanings they would not have had to one skilled in the art having no knowledge of appellant's invention, or to anyone else who can read the specification with understanding.

The first passage cited by the PTO is the second of five "objects" of the invention. (Col. 2, lines 62-67) It reads:

It is another object of this invention to provide a substantially dry free-flowing powder of microscopic discrete capsules of marking fluid which may be applied to paper in a variety of ways and which *does not require an aqueous coating system* in preparing a pressure-sensitive copying material from the capsules. [Our emphasis.]

Both the examiner and the board attempt to use the emphasized words to support the patently absurd notion that Macaulay is suggesting the making of a recording paper having a transfer coating, which the patent states to be one purpose of the invention, by sprinkling dry powder on a piece of paper. What they overlook or purposely ignore is that the specification, before stating the above object, contains a long passage decrying the use of *aqueous* coatings on paper because of their many disadvantages. What the passage is saying is that various binder systems *other than aqueous* may be used with Macaulay's capsules and when he comes to describing them he names several, all of which are used to "affix" the microcapsules to the sheet of paper or whatever.

The next passage, relied on only by the board, is at col. 7, lines 60 et seq. where,

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the board says, "Macaulay addresses the important advantages of the free-flowing capsule powders of his invention." It reads:

Among the important advantages of the free-flowing capsule powders of the invention is the extreme flexibility and versatility in the manner in which they may be applied to web material, such as paper, to provide a pressure sensitive copying material having a coating of the rupturable capsules according to the invention which permits copying.

About this, the board said:

Although Macaulay also discloses that the powders may be applied to a surface having a binder material, to adhere the capsules to the substrate, the overall disclosure of the reference is incompatible with appellant's suggestion that a binder coating is essential.

The argument falls of its own weight since every copying material disclosed in the reference has a binder; but it is also interesting to note that the passage the board relied on follows directly after this short paragraph:

A coating of capsules and binder weighing 1 to 6 lbs., and preferably 2 lbs., per 500 sheets of 20" x 30" paper in which 50 to 95% of the weight of the coating consists of capsules has been found to be satisfactory.

The board's view of the "overall disclosure of the reference" is simply insupportable. Immediately after the sentence about versatility on which the board relied, the specification goes on for at least 30 lines to explain the great variety of *binders* which may be employed, explaining once again that *aqueous* binders can be avoided. Nowhere is the omission of a binder even hinted at as a possibility.

The Solicitor's brief says "Examples I, III, and VI of Macaulay show that one can achieve the desired imaging from microcapsules without having to bond them to a support layer." They show no such thing. They are simply examples of how to make the microcapsules and contain brief general statements at the end of each example on the color of the mark which is produced

when the capsules are used as the patentee intends. They do not undertake to describe the application of the capsules to paper. Furthermore, this is a new argument by the Solicitor not presented to the board.

For the above reasons, we find the § 103 rejection to be in error.

Conclusion

The decision of the board affirming the examiner's rejection of claims 1-20 of application serial No. 770,538 is *reversed*.

REVERSED.



ADAM SOMMERROCK HOLZBAU,
GmbH, Appellant,

v.

The UNITED STATES, Appellee.

No. 88-1448.

United States Court of Appeals,
Federal Circuit.

Jan. 23, 1989.

Government contractor sought judicial review of decision of the Armed Services Board of Contract Appeals dismissing as untimely contractor's claim for attorney fees and expenses under the Equal Access to Justice Act. The Court of Appeals, Nies, Circuit Judge, held that 30-day period for seeking review of determination of fees and expenses under the Equal Access to Justice Act began to run on date of determination, and not on date that the applicant received a copy of that determination.

Appeal dismissed as untimely.

1. United States ¶147(6)

Thirty-day period for seeking review of determination of fees and expenses under